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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,739	02/09/2004	Dean A. Schaefer	1001.1386102	9215
28075	7590	05/28/2008	EXAMINER	
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			VU, QUYNH-NHU HOANG	
			ART UNIT	PAPER NUMBER
			3763	
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			05/28/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/774,739	<b>Applicant(s)</b> SCHAEFER ET AL.	
	<b>Examiner</b> QUYNH-NHU H. VU	<b>Art Unit</b> 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 14 April 2008.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 16-20 and 22-32 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 16-20, 22-32 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:
1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 3763

## DETAILED ACTION

### *Response to Amendment*

Amendment filed on 4/14/08 has been entered.

Claims 16-20, 22-32 are present for examination.

According to the Remarks filed on 4/14/07 states that claim 21 is cancelled. However, Applicant did not cancel claim 21 in the Amendment to Claims' paper. Appropriate correction is required.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the limitation "**wherein the distal shaft portion has fewer axial members than the proximal shaft portion**" of claim 20 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Applicant states that the support for these claim limitation above can be found at page 5, line 23 through page 6, line 5. Examiner agrees. However, the drawings must show every feature of the

Art Unit: 3763

invention specified in the claims but the limitation: **wherein the distal shaft portion has fewer axial members than the proximal shaft portion** does not show in the Figs. 2-5.

***Claim Rejections - 35 USC § 112***

The claims 19-21 are rejection under 35 USC §112, 1<sup>st</sup> paragraph have been withdrawn in view of amendments filed on 4/14/08.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-17, 20, 22, 24, 29-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Webster, Jr. (US 5,057,092).

Webster discloses a catheter comprising: an elongate shaft having a reinforcement layer comprising a tubular braid having a first helical member 24 interwoven with a second helical member 26, and a plurality of axial members 28 disposed between the first helical member and the second helical member.

Additionally, it is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, i.e. “for the entire length of the axial member”, a functional limitation, does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim, see *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974)

Regarding claim 17, the axial members are uniformly spaced about the circumference to the shaft.

Art Unit: 3763

Regarding claim 20, Webster discloses, in Fig. 1, the elongate shaft includes a proximal portion and a distal portion, and wherein the distal shaft portion has fewer axial members 28 than the proximal shaft portion.

Furthermore, it is noted that those skilled in the art will recognize that if an inner diameter of the proximal shaft is larger than an inner diameter of distal shaft portion will give the same result that the distal shaft portion has fewer axial members than the proximal shaft portion. For example, Head (US 6,148,865) is one of evidence shows that the distal shaft portion has fewer the axial members 22 the proximal shaft (see Fig. 3A); or Osborne (US 5,251,640) shows that the distal shaft portion has fewer the axial members 12 the proximal shaft (Figs. 1-5).

Regarding claims 22 and 24, the first and second helical members each comprise polymer material (col. 2, lines 54-65).

Regarding claim(s) 29-30, they encompass the same scope of the invention as to that of claims 16-17 above except they are drafted in method format instead of apparatus format. The claim(s) is/are therefore rejected for the same reason as set forth above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-20, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webster, Jr. (US 5,057,092).

Regarding claims 18-19, as best as understood, Webster, Jr. discloses the claimed invention (see rejection above). Webster does not clearly disclose that four axial members are uniformly spaced apart by 90° about the circumference of the shaft; eight axial members are uniformly spaced apart by 45° about

Art Unit: 3763

the circumference of the shaft. It would have been an obvious matter of design choice to provide the axial members as listed above, since applicant has not disclosed that the number of axial members spaced apart by 45° or 90° solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the device of Webster.

Regarding claims 20, Webster, Jr. discloses the claimed invention (see rejection above). Webster further discloses that the distal shaft portion has few number axial members than the proximal shaft portion. Webster does not clearly disclose that the distal shaft portion has one axial member selected from the plurality of axial member. It is noted that those skilled in the art will recognize that if an inner diameter of the proximal shaft is larger than an inner diameter of distal shaft portion will give the same result that the distal shaft portion has fewer axial members than the proximal shaft portion.

It would have been an obvious matter of design choice to provide the axial members as listed above, since applicant has not disclosed that the number of axial members solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the device of Webster.

Regarding claim(s) 31-32, they encompass the same scope of the invention as to that of claims 18-19 except they are drafted in method format instead of apparatus format. The claims are therefore rejected for the same reason as set forth above.

Claims 23 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webster, Jr. (US 5,057,092) in view of Mortier et al. (US 5,730,733).

Webster, Jr. discloses the claimed invention (see rejection above). Webster does not disclose that the first and second helical members each comprise a plurality of monofilaments; wherein the monofilaments comprise LCP; the monofilaments are arranged side-by-side to collectively define a flat ribbon.

Art Unit: 3763

Mortier discloses that a first and second helical members 32 or 34 (Fig. 2A) each comprises a plurality of monofilaments 26, 36; wherein the monofilaments comprise LCP (liquid crystal polymer material), (col. 4, lines 18-30); the monofilaments are arranged side-by-side to collectively define a flat ribbon.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Webster with a plurality of monofilaments, as taught by Mortier, in order of increase the torsional rigidity and more flexible.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent Nos. 6,709,429.

Claims 16, 22-30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 6-9, 11, 13-28 of U.S. Patent Nos. 6,942,654.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the device and method of instant claims are fully disclosed and covered by the claims in the U.S. patents. 6,709,429 and 6,942,654.

Art Unit: 3763

### ***Response to Arguments***

Applicant's arguments filed 4/14/08 have been fully considered but they are not persuasive.

In response to applicant's argument, the functional recitation that for the entire length of the axial member" has not been given patentable weight because it is narrative in form. If the prior art structure is capable of performing the intended used, and then it meets the claim languages.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to QUYNH-NHU H. VU whose telephone number is (571)272-3228. The examiner can normally be reached on 6:00 am to 3:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas D Lucchesi/  
Supervisory Patent Examiner, Art Unit 3763

Quynh-Nhu H. Vu  
Examiner  
Art Unit 3763